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 SENORX, INC.

IN THE UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORP., and
 HOLOGIC L.P.,

Plaintiffs,

v.

SENORX, INC.,

Defendant.

CASE NO.: C08-0133 RMW

**MOTION FOR ADMINISTRATIVE
 RELIEF FOR PERMISSION TO
 FILE SUPPLEMENTAL CLAIM
 CONSTRUCTION BRIEFS
 PURSUANT TO CIVIL LOCAL
 RULES 7-11 AND 7-12**

Plaintiffs Hologic, Inc., Cytac Corporation, and Hologic L.P. and Defendant SenoRx, Inc. hereby jointly move, pursuant to Civil Local Rule 7-11, for permission to file supplemental claim construction briefs. In support of this motion, the parties submit a stipulation pursuant to Civil Local Rule 7-12.

The claim construction hearing in this case is scheduled to be held on June 25, 2008. The parties submitted opening claim construction briefs on May 21, 2008 and responsive claim construction briefs May 30, 2008. Subsequent to submitting these briefs, the parties determined there was a dispute as to the meaning of additional claim terms in the patents-in-suit that were not raised in the parties' original claim construction briefs. Accordingly, the parties request that the Court consider and issue a ruling on the parties' supplemental claim constructions of the disputed terms. Plaintiffs' supplemental claim construction brief, with exhibits, is attached as Exhibit A to this Motion. Defendant's supplemental claim construction brief, with exhibits, is attached as Exhibit B to this Motion.

Dated: June 20, 2008

HOWREY LLP

By: /s/Marc Cohn

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5 Attorneys for Defendant
6 SENORX, INC.

Filer's Attestation

I, F.T. Alexandra Mahaney, am the ECF User whose identification and password are being used to file this Motion for Administrative Relief for Permission to File Supplemental Claim Construction Briefs. Pursuant to General Order No. 45, ¶ X(B), I attest under penalty of perjury that concurrence in the filing of the document has been obtained from the other signatures above.

By: /s/F.T. Alexandra Mahaney
F.T. Alexandra Mahaney

CERTIFICATE OF SERVICE
U.S. District Court, Northern District of California,
Hologic, Inc. et al. v. SenoRx, Inc.
Case No. C-08-0133 RMW (RS)

I, Kirsten Blue, declare:

I am and was at the time of the service mentioned in this declaration, employed in the County of San Diego, California. I am over the age of 18 years and not a party to the within action. My business address is 12235 El Camino Real, Ste. 200, San Diego, CA, 92130.

On June 20, 2008, I served a copy(ies) of the following document(s):

**MOTION FOR ADMINISTRATIVE RELIEF FOR PERMISSION TO FILE
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEFS PURSUANT TO CIVIL
LOCAL RULES 7-11 AND 7-12**

**EXHIBIT A TO MOTION FOR ADMINISTRATIVE RELIEF TO FILE
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEFS: PLAINTIFFS'
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF; DECLARATION OF
MARC COHN**

**EXHIBIT B TO MOTION FOR ADMINISTRATIVE RELIEF FOR PERMISSION
TO FILE SUPPLEMENTAL CLAIM CONSTRUCTION BRIEFS: DEFENDANT
SENO RX, INC'S SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF
[REDACTED VERSION]; DECLARATION OF ADAM HARBER**

**STIPULATION IN SUPPORT OF MOTION FOR ADMINISTRATIVE RELIEF
FOR PERMISSION TO FILE SUPPLEMENTAL CLAIM CONSTRUCTION
BRIEFS PURSUANT TO CIVIL LOCAL RULES 7-11 AND 7-12**

**[PROPOSED] ORDER GRANTING MOTION FOR ADMINISTRATIVE RELIEF
FOR PERMISSION TO FILE SUPPLEMENTAL CLAIM CONSTRUCTION
BRIEFS PURSUANT TO CIVIL LOCAL RULES 7-11 AND 7-12**

on the parties to this action by the following means:

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CORPORATION and
HOLOGIC LP

- 1 ☒ (BY MAIL) I placed the sealed envelope(s) for collection and mailing by following the
 2 ordinary business practices of Wilson Sonsini Goodrich & Rosati, 12235 El Camino Real,
 3 Ste. 200, San Diego, CA. I am readily familiar with WSGR's practice for collecting and
 4 processing of correspondence for mailing with the United States Postal Service, said
 5 practice being that, in the ordinary course of business, correspondence with postage fully
 6 prepaid is deposited with the United States Postal Service the same day as it is placed for
 7 collection.
- 8 ☒ (BY ELECTRONIC MAIL) I caused such document(s) to be sent via electronic mail
 9 (email) to the above listed names and email addresses.
- 10 ☐ (BY PERSONAL SERVICE) I caused to be delivered by hand to the addressee(s) noted
 11 above. I delivered to an authorized courier or driver to be delivered on the same date. A
 12 proof of service signed by the authorized courier will be filed with the court upon
 13 request.
- 14 ☐ (BY OVERNIGHT DELIVERY) I placed the sealed envelope(s) or package(s), to the
 15 addressee(s) noted above, designated by the express service carrier for collection and
 16 overnight delivery by following the ordinary business practices of Wilson Sonsini
 17 Goodrich & Rosati, 12235 El Camino Real, Ste. 200, San Diego, CA. I am readily
 18 familiar with WSGR's practice for collecting and processing of correspondence for
 19 overnight delivery, said practice being that, in the ordinary course of business,
 20 correspondence for overnight delivery is deposited with delivery fees paid or provided for
 21 at the carrier's express service offices for next-day delivery the same day as the
 22 correspondence is placed for collection.
- 23 ☐ (BY FACSIMILE) I caused to be transmitted by facsimile machine (number of sending
 24 facsimile machine is (858) 350-2399 at the time stated on the attached transmission
 25 report(s) by sending the documents(s) to (see above). The facsimile transmission(s)
 26 was/were reported as complete and without error.
- 27 ☒ (BY CM/ECF) I caused such document(s) to be sent via electronic mail through the Case
 28 Management/Electronic Case File system with the U.S. District Court for the Northern
 District of California.

I declare under penalty of perjury under the laws of the United States that the above is true
 and correct, and that this declaration was executed on June 20, 2008.



Kirsten Blue

EXHIBIT A

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORPORATION,
and HOLOGIC L.P.,

Plaintiffs,

vs.

SENORX, INC.,

Defendant.

AND RELATED COUNTERCLAIMS.

Case No. C08 00133 RMW (RS)

**PLAINTIFFS' SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEF**

Markman Hearing
Date: June 25, 2008
Time: 2:00 p.m.
Room: Courtroom 6, 4th Floor
Judge: Hon. Ronald M. Whyte

1 Plaintiffs Hologic, Inc., Cytac Corporation, and Hologic L.P. (“Hologic”) respectfully submit
 2 this Supplemental Claim Construction Brief addressing additional terms that Defendant SenoRx, Inc.
 3 (“SenoRx”) believes require further construction by the Court. The terms appears in U.S. Patent Nos.
 4 5,913,813 (the “‘813 patent”), 6,413,204 (the “‘204 patent”), and 6,482,142 (the “‘142 patent”)
 5 (collectively, “the patents-in-suit”). By way of Stipulation and an Administrative Motion, the parties
 6 have agreed to brief this dispute, and seek leave to do so, with the intent that the Court may entertain
 7 oral argument at the scheduled June 25, 2008 claim construction hearing.

8 INTRODUCTION

9 SenoRx attempts to inject new questions of claim construction regarding terms that it has
 10 already briefed, or previously agreed require no construction. Its purported justification – that
 11 Hologic’s expert, Dr. Verhey, provides new constructions in his expert report – is false. Dr. Verhey
 12 applied the same constructions that Hologic proposed in its initial claim construction brief. SenoRx is
 13 belatedly disputing Hologic’s proposed constructions and asserting new arguments. None of these
 14 terms requires further construction.

15 Nevertheless, recognizing that claim construction is a legal issue for the Court to decide, the
 16 parties have agreed to submit this dispute to the Court for resolution in the context of the June 25, 2008
 17 claim construction hearing. The claim terms at issue in this Supplement are: (A) “radial absorbed
 18 dose profile” (‘813 patent, claim 1); (B) “uniform radiation profile” (‘813 patent, claim 1); (C) “the
 19 expandable outer surface element is . . . adapted to contact / conform the tissue” (‘204 patent, claim 4);
 20 (D) “the expandable outer surface is sufficiently rigid to deform the target tissue (‘142 patent, claim 8);
 21 and (E) “predetermined asymmetric isodose curves . . .” (‘142 patent, claims 1 & 8).

22 Hologic asserts that these terms should be construed in accordance with their plain meaning.
 23 Indeed, the parties have already briefed most of these terms. Some have already been construed by the
 24 Court in the *Xoft* litigation¹. The same constructions should apply here. Hologic requests that the
 25 Court decline SenoRx’s invitation to engage in further, unnecessary claim construction.

27 ¹ As discussed previously, many of the claim terms at issue in this case have already been construed by
 28 this Court in a prior infringement action involving two of the three patents asserted here. *Xoft, Inc. v.*
 (Continued...)

1 **I. ARGUMENT**

2 **A. “radial absorbed dose profile” (‘813 patent, claim 1(e)) (no further construction is**
 3 **necessary)**

4 The term “radial absorbed dose profile” appears in element (e) of claim 1 of the ‘813 patent. In
 5 the *Xoft* litigation, the meaning of this claim language was fully briefed, argued, and considered by the
 6 Court. Dkt. No. 135-6 at 8-10. The parties have already fully briefed the meaning of this element in
 7 this case as well. *See* Dkt. No. 130 at 14-17 (SenoRx’s Opening Claim Construction Brief); Dkt. No.
 8 132 at 11-12 (Orton Decl. supporting SenoRx’s Opening Brief); Dkt. No. 134 at 9-10 (Hologic’s
 9 Opening Claim Construction Brief); Dkt. No. 141 (SenoRx’s Reply Brief); Dkt. No. 144 (Hologic’s
 10 Reply Brief). Neither party argued that the term “radial absorbed dose profile” is ambiguous or
 11 requires further construction. Because Dr. Verhey’s report is fully consistent with Hologic’s
 12 preliminary infringement contentions served over a month ago, there is no basis for SenoRx to now
 13 assert that it needs to construe this language differently than it did before.

14 SenoRx’s proposed new construction adds ambiguity to the language chosen by the patentee.
 15 SenoRx attempts to change the scope of the claim such that the word “‘uniform’ does not require that
 16 the tissue and the balloon conform to each other or relate to the shape of the isodose curve” As a
 17 threshold matter, defining the disputed term of claim element 1(e) by setting forth specific examples of
 18 what it purportedly does *not* require does not help elucidate its meaning. Furthermore, SenoRx is
 19 wrong. As the prosecution history explains, the term “uniform” *does* encompass the requirement that
 20 the tissue and the outer balloon conform to each other. *See* Cohn Decl., Ex. 1 at 39 (Verhey Expert
 21 Report) (“[I]t is critical to the claimed invention that the tissue and the balloon conform to each other –
 22 this is the primary way to achieve a ‘uniform’ dose.”) (citing prosecution history). This is implicit in
 23 the Court’s previous construction. That construction should apply here as well. SenoRx’s proposed
 24 additional language is confusing and inaccurate – and should be rejected.

25 _____
 26 (...Continued)

27 *Cytac Corp. et. al.*, Case No. C-05-05312 RMW (the “*Xoft* litigation”) (involving both the ‘813 and
 28 ‘204 patents).

B. “uniform radiation profile” (‘813 patent, preamble) (no further construction is necessary)

SenoRx contends that the preamble of claim 1 is not limiting, but this is incorrect. The patentee amended the preamble of claim 1 during prosecution to distinguish the claimed invention as an apparatus for delivering radioactive emissions with a “*uniform*” radiation profile from the prior art. Dkt. No. 135-10 at 1-7 (Sept. 1, 1998 Amend. to claim 1 preamble). Contrasting the invention with the prior art, the patentee explained that “Applicants’ invention is specifically designed to provide a uniform radial absorbed dose profile of the emissions from the particular chamber containing the radioactive material . . .” *Brassica Protection Products LLC v. Sunrise Farms*, 301 F.3d 1343, 1347 (Fed. Cir. 2002) (reliance on the preamble during prosecution to distinguish the claimed invention from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention); *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09 (Fed. Cir. 2002) (same). Were that not the case, there would have been no reason for the amendment, which replaced the word “controlled” with the word “uniform” in the preamble of claim 1.

It does not follow, however, as SenoRx contends, that the phrase “uniform radiation profile” is ambiguous or requires further construction. The preamble and claim element 1(e), discussed above, were amended at the same time and for the same reasons. They should be construed consistently. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001). Because the Court has already considered and construed claim element 1(e), the same construction should apply to “uniform radiation profile” in the preamble. Nothing in Dr. Verhey’s report or elsewhere justifies altering the Court’s prior construction.

C. “the expandable outer surface element is . . . adapted to contact / conform the tissue” (‘204 patent, claim 4) (no further construction is necessary)

Claim 4 of the ‘204 patent describes an apparatus with an expandable surface element adapted to contact tissue surrounding a cavity and to conform the tissue to the shape of the expandable surface element – *i.e.*, the expandable surface element exerts force against the tissue to change its shape, thereby enabling a more uniform or homogeneous distribution of radiation. SenoRx’s contention that

claim 4 describes a structure that *theoretically could* contact and conform the surrounding tissue, *but which does not actually do so*, ignores the express teachings of the specification and the very purpose of the claimed invention.

The specification repeatedly states that the objective of contacting and conforming the target tissue is to enable a more uniform distribution of radiation. Col. 2:7-33; 7:6-28. A structure adapted to conform the tissue achieves this precise objective. SenoRx's proposed construction would render claim 4 meaningless. An apparatus that does not exert pressure and conform the target tissue will not achieve the goal of providing more uniformity. SenoRx's proposed language would result in a claim that adds nothing to the inventions already set forth in claims 1-3.

SenoRx again attempts to construe claim language in a vacuum – disregarding the context and the teachings of the specification. *MedRad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (words in patent must be interpreted in light of the claims and the written description). The '204 patent's specification explains the objective of keeping the radiation within a narrow absorbed dose range to prevent over-exposure of tissue at or near the expandable surface, while still delivering the minimum prescribed dose to tissue some distance away from the expandable surface. Col. 2:21-34. Shaping the target tissue is important to achieving this objective. Col. 5:55-62 (“... then expanded to cause the tissue surrounding the surgically resected region to take the appropriate shape ... allowing the expandable surface of the outer spatial volume to urge tissue on the surface of the resected region into the appropriate shape to promote an even dose distribution around the outer spatial volume in the target tissue.”); *see also* Col. 6:17-19 (same); Col. 6:57-7:5 (same). Claim 4 is specifically directed to a device that is designed to contact and conform the target tissue to achieve a more uniform dose distribution. SenoRx's proposed construction is wrong and must be rejected.

D. “the expandable outer surface is sufficiently rigid to deform the target tissue (‘142 patent, claim 8) (no further construction is necessary)”

This claim term presents the same issue discussed in Section C, above. For the same reasons, SenoRx's proposed construction should be rejected. *See* '142 patent, Col. 5:47-50 (the objective is “to keep the maximum radiation dose delivered ... as low as possible while still delivering the desired

therapeutic dose to the desired range of tissue.”); col. 4:42-55 (in some embodiments, the surface of the outer volume can be . . . expanded to cause the tissue surrounding the surgically resected region to take the appropriate shape . . . in [some] applications, the outer spatial volume will be slightly larger than the resected volume, allowing the expandable surface of the outer spatial volume to urge tissue on the surface of the resected region into the appropriate shape to promote an even dose distribution around the outer spatial volume in the target tissue.” *See also* Col. 6:19-23 (same).

SenoRx also ignores the remaining language of claim 8, which makes clear that the claimed structure is not merely capable of deforming the target tissue – rather, it actually deforms the tissue. Claim 8 states:

The apparatus of claim 1, wherein the expandable outer surface is sufficiently rigid to deform the target tissue into the shape of the expandable outer surface, ***causing the predetermined asymmetric isodose curves to penetrate into the target tissue to a prescribed depth.***

An apparatus that that does not actually deform the target tissue would not “caus[e] the predetermined asymmetric isodose curves to penetrate into the target tissue to a prescribed depth. Cohn Decl., Ex. 1 at 79-80) (Verhey Expert Report). *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (claim language must be construed in the context of the particular claim in which the disputed term appears). Indeed, SenoRx’s own expert, Dr. Orton, in the context of his invalidity opinions, which Hologic disputes, agreed that the structure of the claimed invention must actually deform tissue:

A person of ordinary skill in the art would understand that, the outer balloon of the Ashpole device . . . is sufficiently rigid when inflated to deform brain tissue into the shape of the expandable outer surface, ***which would cause the predetermined asymmetric isodose curves to penetrate into the target tissue to the prescribed depth. By filling the postsurgical cavity and deforming the target tissue into the shape of the balloon, the Ashpole device makes it possible to deliver the prescription dose to the prescribed depth of 0.5 c.m.***” Cohn Decl., Ex. 2 at 36-37 (Orton Expert Report).

While Hologic disputes that Ashpole in fact discloses this teaching, it agrees with Dr. Orton that any prior art device, in order to anticipate claim 8, must include a structure that actually deforms tissue (which Ashpole does not do). SenoRx’s proposed construction should be rejected.

1 E. **“predetermined asymmetric isodose curves . . .” (‘142 patent, claims 1 & 8) (no**
 2 **further construction is necessary)**

3 The parties have each submitted claim construction briefs on the meaning of “predetermined
 4 asymmetric isodose curves . . .” SenoRx now seeks to further construe this claim term contrary to its
 5 plain meaning, without any justification in the intrinsic evidence.

6 As used in the related ‘204 patent, the Court already found that “predetermined” means
 7 “determined in advance.” Dkt. No. 135-6 at 25 (Claim Construction Order in the *Xoft* litigation). It
 8 does not mean determined “prior to treatment” (as SenoRx suggests) or for that matter, prior to any
 9 other specified event. Such a construction would improperly limit an apparatus claim to a particular
 10 method of treatment – something that is intended to be left up to the discretion of the ordinarily skilled
 11 user.

12 Further, SenoRx seeks to define “predetermined asymmetric isodose curves” (again, contrary to
 13 the plain meaning) to mean any isodose curves that happen to result from treatment planning,
 14 regardless of whether the user intended to produce asymmetric curves. For example, under SenoRx’s
 15 rationale, where a user intends to produce symmetric isodose curves, but *asymmetric* curves
 16 inadvertently result, the curves would nonetheless qualify as “predetermined asymmetric isodose
 17 curves” because the user intended to produce *something* – even though her intention was to produce
 18 something else. This strained construction directly conflicts with the ‘142 specification, which
 19 explains the circumstances in which users *intentionally* position the radiation source(s) to cause an
 20 asymmetric isodose profile. Col. 2:39-43 (“It is also desirable . . . to provide these advantages while
 21 *tailoring* the radiation dosage to avoid fully dosing sensitive tissue or to reduce the amount of radiation
 22 that escapes the patient’s body.”); Col. 2:42-54 (“There is still a need for an instrument . . . with the
 23 ability to *shape* the radiation dose to protect sensitive tissue or to protect against radiation exposure
 24 outside of the patient’s body which may affect healthcare providers or others who might come close to
 25 the patient.”).

26 Whether the phrase “predetermined asymmetric isodose profile” is construed in isolation or
 27 more correctly, in light of the written description, it is nonsensical to define it in a way that includes a
 28

1 situation where a user intends to produce a *different* result but fails to do so for whatever reason.
2 SenoRx's motivation in pushing this contrived construction (in an attempt to incorporate alleged prior
3 art) conflicts with the claim term's plain meaning – and should be rejected. The phrase
4 “predetermined asymmetric isodose profile” requires no additional construction.

5 **II. CONCLUSION**

6 Hologic respectfully requests that the Court reject SenoRx's newly proposed constructions.
7 None of the claim terms discussed herein require further construction by the Court.

8 Dated: June 20, 2008

HOWREY LLP

9
10 By: 

11 Marc A. Cohn
12

13 HOWREY LLP
14 Attorneys for Plaintiffs
15 Hologic, Inc., Cytoc Corporation,
16 and Hologic L.P.
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Attorneys for Plaintiffs
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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORPORATION,
and HOLOGIC L.P.,

Plaintiffs,

vs.

SENORX, INC.,

Defendant.

AND RELATED COUNTERCLAIMS.

Case No. C08 00133 RMW (RS)

**DECLARATION OF MARC A. COHN
IN SUPPORT OF PLAINTIFFS'
SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEF**

Markman Hearing
Date: June 25, 2008
Time: 2:00 p.m.
Room: Courtroom 6, 4th Floor
Judge: Hon. Ronald M. Whyte


1 I, Marc A. Cohn, declare that I am an attorney with the law firm of Howrey LLP and admitted
2 to appear before this Court *pro hac vice*. I serve as one of the outside counsel for Plaintiffs Hologic,
3 Inc., Cytoc Corporation and Hologic L.P. ("Hologic"). The following declaration is based on my
4 personal knowledge. If called to testify, I could and would competently testify as to the matters set
5 forth below.

6 1. Attached hereto as Exhibit 1 is a true and correct copy of excerpts from the June 4, 2008
7 Expert Report of Lynn J. Verhey, Ph.D.

8 2. Attached hereto as Exhibit 2 is a true and correct copy of excerpts from the June 4, 2008
9 Expert Report of Colin G. Orton, Ph.D.

10 I declare under penalty of perjury that the foregoing is true and correct.

11 Executed on June 20, 2008 at East Palo Alto, California

12
13
14 
Marc A. Cohn

15
16 HOWREY LLP
17 Attorneys for Plaintiffs
18 Hologic, Inc., Cytoc Corporation,
19 and Hologic L.P.
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27
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Exhibit 1

CONFIDENTIAL
CONTAINS INFORMATION SUBJECT TO PROTECTIVE ORDER

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORPORATION,
and HOLOGIC L.P.,

Plaintiffs,

vs.

SENORX, INC.,

Defendant.

Case No. C08 00133 RMW (RS)

AND RELATED COUNTERCLAIMS.

EXPERT REPORT OF LYNN J. VERHEY, Ph.D.

CONFIDENTIAL
CONTAINS INFORMATION SUBJECT TO PROTECTIVE ORDER

Ashpole therefore teaches “over-treatment of body tissue at or close to the outer wall of the instrument,” which the claimed device must prevent according to the Court’s prior construction of “render uniform.” For this reason, Ashpole does not teach the device in claim 11 and, therefore, does not anticipate claim 11, expressly or inherently. Moreover, I must note that Ashpole expressly describes that the tolerance of brain tissue to radiation is 55-60 Gy – the provision of 70 Gy or more is therefore “over treatment” of tissue as defined by Ashpole.

In addition, Ashpole does not disclose that the balloon is expanded to conform the shape of the cavity to the outer surface of the balloon, or that the balloon comes into contact with the tumor bed at all points, or that the distance from the tumor bed to the radiation source can be adjusted through expansion of the balloon. Indeed, it is critical to the claimed invention that the tissue and the balloon conform to each other – this is the primary way to achieve a “uniform” dose. During prosecution, when the terms “uniform” and “render uniform” were added to the claims to overcome prior art, the applicant stated that, in order to have dose “uniformity,” there must be constant distance between the radiation source and the tissue being treated:

Applicants invention is specifically designed to provide a uniform radial absorbed dose profile of the emissions from the particular chamber containing the radionuclide material so that occurrences of “hot spots” and/or “cold spots” are substantially eliminated. Hot spots can result in necrosis of healthy tissue, a condition to be avoided, while cold spots may mean that cancerous cells are not irradiated and killed. ***In one embodiment, uniformity of the radial absorbed profile is achieved by providing a spherical outer chamber which when inflated to contact the cavity margins resulting from surgical removal of the tumor, a desired constant spacing will be maintained between the radiation source and the adjacent tissue structures.***

(Amendment dated 9-1-98 at 6 (emphasis added).) One cannot have a “constant spacing . . . maintained between the radiation source and the adjacent tissue structures” unless the tissue contacts the balloon at all points. If the tissue did not so contact the balloon, then

CONFIDENTIAL
CONTAINS INFORMATION SUBJECT TO PROTECTIVE ORDER

6.5.2.1.1. Ashpole

Ashpole does not anticipate claim 8 of the '142 patent. I disagree with SenoRx's contention that Ashpole anticipates claim 8. In my opinion, Ashpole does not disclose the following claim elements:

- (A) an expandable outer surface defining a three-dimensional apparatus volume configured to fill an interstitial void created by the surgical extraction of diseased tissue and define an inner boundary of the target tissue being treated
 - (B) the radiation source further being asymmetrically located and arranged within the expandable surface to provide predetermined asymmetric isodose curves with respect to the apparatus volume.
 - (C) wherein the expandable outer surface is sufficiently rigid to deform the target tissue into the shape of the expandable outer surface, causing the predetermined asymmetric isodose curves to penetrate into the target tissue to a prescribed depth
- (A) See my analysis under 6.5.1.1.1(A).

Thus, there is no express or inherent disclosure of this claim element in Ashpole and Ashpole, therefore, does not anticipate claim 8 of the '142 patent.

- (B) See my analysis under 6.5.1.1.1(B).

Accordingly, Ashpole does not disclose this claim element, expressly or inherently and it therefore cannot anticipate claim 8.

(C) Ashpole does not describe "wherein the expandable outer surface is sufficiently rigid to deform the target tissue into the shape of the expandable outer surface, causing the predetermined asymmetric isodose curves to penetrate into the target tissue to a prescribed depth." SenoRx has cited only pages 334-36 and Figure 3 of Ashpole in contending that Ashpole describes this claim element. There are no specific citations to any language in these passages nor is any language quoted by SenoRx in its contentions. I see nothing in the cited passages that shows the element above.

The claim language provides that the expandable outer surface must "deform the target tissue into the shape of the expandable surface." This means more than that the

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CONTAINS INFORMATION SUBJECT TO PROTECTIVE ORDER

outer surface of the device must touch (or very nearly touch) the entire surface of the target tissue – it means that the balloon must apply force to the target tissue to deform it to the balloon’s shape. Ashpole does not teach that the outer surface of the balloon even touches all points of the tissue (to define an inner boundary of the target tissue) much less that it presses against the tissue to deform it to the balloon’s shape. Ashpole only mentions “filling” the cavity with the balloon, which one skilled in the art would understand to mean that the balloon is inflated until it contacts surrounding brain tissue – it is not an express teaching that the tissue conforms to the balloon (or even that the balloon conforms to the tissue).

There is also no inherent description of the balloon conforming tissue to the balloon because the balloon is capable of filling the cavity without conforming the tissue to its shape.

Moreover, while SenoRx contends that figure 3 shows the tissue conformed to the balloon, this is not necessarily the case. The lateral radiographic image is merely a two-dimensional slice of a three-dimensional cavity. It is quite possible – indeed, likely – that there is some space between the cavity and the balloon in the parts of the cavity that lie outside the figure, *i.e.*, in front of or behind it.

Thus, there is no express or inherent disclosure of this claim element in Ashpole and Ashpole, therefore, does not anticipate claim 8 of the ‘142 patent.

6.5.2.1.2. Williams ‘774

Williams ‘774 does not anticipate claim 8 of the ‘142 patent. I disagree with SenoRx’s contention that Williams ‘774 anticipates claim 8. In my opinion, Williams ‘774 does not disclose the following claim elements:

- (A) the radiation source further being asymmetrically located and arranged within the expandable surface to provide predetermined asymmetric isodose curves with respect to the apparatus volume.

Exhibit 2

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORPORATION and)
HOLOGIC L.P.,)

Plaintiffs,)

v.)

SENORX, INC.,)

Defendant.)

SENORX, INC.,)

Counterclaimant,)

v.)

HOLOGIC, INC., CYTYC CORP., and)
HOLOGIC L.P.,)

Counterdefendants.)

Case No. 08-CV-0133 RMW

**EXPERT REPORT OF COLIN G.
ORTON, Ph.D.**

'142 Patent, Claim 1	Ashpole Disclosure
<p>a radiation source disposed completely within the expandable outer surface and located so as to be spaced apart from the apparatus volume,</p>	<p>If Plaintiffs' interpretation is adopted, the radiation bead(s) described in Ashpole is disposed within the expandable outer surface and spaced apart from the outer surface because it is inside the catheter body. pp. 333-34; Figs. 1 & 3.</p>
<p>The radiation source further being asymmetrically located and arranged within the expandable surface to provide predetermined asymmetric isodose curves with respect to the apparatus volume.</p>	<p>The authors make clear that if matching the shape of the cavity does not produce a satisfactory dose curve for an individual tumor bed, "[a] certain measure of dosimetrical versatility is possible in that the positions of the active beads can be changed to produce an isodose distribution specific to the geometry of the individual tumour beds." <i>See</i> p. 336. The person of ordinary skill would understand from Ashpole that one circumstance in which this was desirable is discussed at page 334 where only "as much [of the] tumour was removed as deemed safe." Such a person would understand that when the remaining tumor tissue was located, for example, near the distal end of the device, the radiation source should be arranged and predetermined to deliver more radiation nearer the remaining "tumour beds" at the distal end of the device (i.e., locating the radiation sources off center in the balloon).</p>

'142 Patent, Claim 8	Ashpole Disclosure
<p>The apparatus of claim 1, wherein the expandable outer surface is sufficiently rigid to deform the target tissue into the shape of the expandable outer surface, causing the predetermined asymmetric isodose curves to penetrate into the target tissue to a prescribed depth.</p>	<p><i>See</i> '204 Patent, claim 4.</p> <p>A person of ordinary skill in the art would understand that, the outer balloon of the Ashpole device, which was made with a Portex, Blue Line endotracheal tube, i.d. 8.0 with a Profile cuff, <i>see</i> p. 334, is sufficiently rigid when inflated to deform brain tissue into the shape of the expandable outer surface, which would cause the predetermined asymmetric isodose curves to penetrate into the target tissue to the prescribed depth. By filling the postsurgical</p>

'142 Patent, Claim 8	Ashpole Disclosure
	cavity and deforming the target tissue into the shape of the balloon, the Ashpole device makes it possible to deliver the prescription dose to the prescribed depth of 0.5 cm. <i>See</i> p. 335 & Fig. 3.

109. In addition to my opinion that Ashpole, both alone and in combination with the general knowledge of a person of ordinary skill in the art, anticipates the asserted claims of the patents-in-suit, it is my opinion that Ashpole combined with Friedman 1958 renders the asserted claims of the '813 and '204 patents obvious. A person skilled in the art, starting with Ashpole, would be motivated to combine these references because such a person interested in interstitial use would start with Ashpole, and Friedman 1958 teaches a very similar device that would be of interest to someone attempting to make an Ashpole-like balloon brachytherapy device with a single radioactive source. For example, Johannesen utilized a single-source Ashpole device during the 1990s after reviewing the Ashpole disclosure. For the reasons discussed in paragraphs 87 to 116 regarding Ashpole and in paragraphs 122 to 136 regarding Friedman 1958, including the tables, these references render the claimed inventions of the '813 and '204 patents obvious.

110. For the same reasons, a person of ordinary skill would be motivated to combine Ashpole with Johannesen. Indeed, I understand that Johannesen's use and public description of the apparatus and method described in his article was motivated by the Ashpole article and method. For the reasons discussed in paragraphs 87 to 116 regarding Ashpole and paragraphs 154 to 164 regarding Johannesen, including the tables, these references render the claimed inventions of the '813 and '204 patents obvious.

111. In addition, Ashpole combined with either Low-Beer 1950 or Low-Beer 1954 renders the asserted claims of the '813 and '204 patents obvious. A person skilled in the art, starting with Ashpole, would be motivated to combine these references because such a person interested in interstitial use would start with Ashpole, and both Low-Beer 1950 and Low-Beer 1954 teach a very similar device that would be of interest to someone attempting to make an

EXHIBIT B

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PRELIMINARY STATEMENT

In their *Markman* briefs, Plaintiffs made plain they intend to argue claim construction to the jury in support of their infringement case against SenoRx. With the submission of Dr. Lynn Verhey's expert report, Plaintiffs again make plain their intent to argue claim construction to the jury – this time to avoid invalidity of the patents-in-suit over the prior art. Dr. Verhey's expert report, submitted on June 4, 2008, disclosed that Dr. Verhey plans to present at trial new claim construction arguments to distinguish the prior art and rebut SenoRx's invalidity case. These new claim constructions were neither disclosed by Plaintiffs, briefed by the parties, nor presented to the Court as required by the Patent Local Rules. And substantively, they are wrong. Dr. Verhey's proffered opinions regarding the meaning of the claims are inconsistent with the claim language and unsupported by the teachings of the patents-in-suit.

Not surprisingly, Plaintiffs seek to avoid a ruling on the meaning of the terms at issue, arguing, just as in their *Markman* briefs, that the claim terms should be given their "plain meaning," or that they require no further construction beyond what Plaintiffs first proposed in their *Markman* briefs. The Court should not accept Plaintiffs' invitation to decline to construe these terms, as the parties dispute their meaning. As SenoRx previously noted, the law provides that "[w]hen the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute." *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008). Accordingly, the Court should construe the claim terms at issue consistent with SenoRx's proposed constructions, thereby preventing Plaintiffs' expert from presenting to the jury invalidity positions based on erroneous constructions. *See id.*¹

¹ Alternatively, SenoRx requests that the Court treat this supplemental *Markman* brief as a motion *in limine* to exclude Dr. Verhey's testimony on the new claim construction arguments identified herein.

CONSTRUCTION OF THE DISPUTED TERMS

A. Uniform Radial Absorbed Dose Profile ('813 Patent Claim 1).

Claim Term	SenoRx's Proposed Construction
uniform radial absorbed dose profile ('813 patent, claim 1(e))	The "radial absorbed dose profile" means the absorbed dose as a function of distance in a radial direction from the outer surface of the radiation transparent wall. "Uniform" does not require that the tissue and the balloon conform to each other or relate to the shape of the isodose curve; instead, it refers to the slope of the dose profile as discussed in SenoRx's previous briefing.
uniform radiation profile ('813 patent, preamble)	[If the preamble is a claim limitation] The "radiation profile" means the absorbed dose as a function of distance in a radial direction from the outer surface of the radiation transparent wall. "Uniform" does not require that the tissue and the balloon conform to each other or relate to the shape of the isodose curve; instead, it refers to the slope of the dose profile as discussed in SenoRx's previous briefing.

Prior to the submission of Dr. Verhey's expert report on June 4, 2008, the parties agreed that "uniform radial absorbed dose profile" and "uniform radiation profile" in claim 1 of the '813 patent referred to the strength of the dose in the tissue at various distances from the radiation source. Dr. Verhey's report now asserts that these terms address a different subject: whether the surface of the outer balloon contacts the tissue at all points so that there is conformance between the tissue and the balloon. Plaintiffs' newly-minted construction is simply wrong.

As SenoRx explained in its *Markman* brief, the '813 patent teaches that "radial absorbed dose profile" refers to the radiation dose absorbed in the tissue measured as a function of distance in a radial (*i.e.*, outward) direction from the outer balloon. *See* SenoRx Opening Brief ("Op. Br.") at 9-10. Put another way, a "radial absorbed dose profile" plots the strength of the radiation dose within the target tissue as the radiation progresses outward from the radiation source and into the tissue. *See generally* Ex. 1 ('813 patent), col. 3:13-37; fig. 5.² The '813 patent represents the dose profile in Figure 4, which depicts a line plotting the radiation dose

² Exs. 1-14 are exhibits to the Declaration of Adam D. Harber in Support of SenoRx's Opening Claim Construction Brief, Exs. 15-17 are exhibits to the Declaration of Adam D. Harber in Support of SenoRx's Responsive Claim Construction Brief, and Exs. 18-21 are exhibits to the Declaration of Adam D. Harber in Support of SenoRx's Supplemental Claim Construction Brief.

1 absorbed in the tissue on the y axis, and the distance from the outer balloon to the target depth in
 2 the tissue on the x axis. *See id.* Rendering the “absorbed dose profile” more “uniform” means to
 3 reduce the slope of this line, which indicates there is less variation in the strength of the radiation
 4 dose at various distances outward from the surface of the balloon to the edge of the target depth
 5 in the tissue.

6 This is exactly how the Court described the dose profile in its construction of claim
 7 element 1(e) in the *Xoft* case. *See* Ex. 4 (*Xoft* Cl. Constr. Order) at 8-9 (reproducing Figure 4 of
 8 the ’813 patent and discussing reducing the slope of the dose profile). And, it is exactly how
 9 Plaintiffs described the claim element in their *Markman* briefs. Plaintiffs argued the
 10 “uniformity” of a radiation profile is measured over a “distance from the center of the cavity
 11 along a direction of interest” and is characterized by the “flatter” line 42 shown in Figure 4 of the
 12 ’813 patent. *See* Pls’ Cl. Constr. Br. at 9 (emphasis added). Plaintiffs even reproduced Figure 4
 13 of the ’813 patent in their brief and argued that the “written description explains the objective of
 14 flattening line 40 to achieve an absorbed dose profile depicted by line 42,” thus making the point
 15 that a “uniform” radiation profile was achieved over the span of distance from radiation source,
 16 as represented by the “flatter” slope of line 42. *See* Pls’ Cl. Constr. Br. at 9 (citing ’813 patent,
 17 col. 4:14-38) (emphasis added).

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 25 ³ By contrast, claim 4 of the ’204 patent requires that the “expandable surface element is
 26 adapted to contact tissue surrounding a resected cavity and adapted to conform the tissue to the
 27 desired shape of the expandable surface element.” Ex. 2 (’204 patent), claim 4. While this
 28 element does not require actual conformance, *see* discussion *infra* Section B, Dr. Verhey is
 attempting to import this element from an interstitial device into a claim that is not limited to
 interstitial cavities.

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[REDACTED]

For the reasons discussed *supra*, Dr. Verhey’s construction of “uniform” in claim element 1(e) of the ’813 patent should be rejected. Plaintiffs’ new position is flatly inconsistent with the Court’s and their own prior construction, and it is contradicted by the teachings of the ’813 patent. There is simply no basis anywhere in the patent for a conformance requirement. The patent requires only that the inner and outer volumes are “filled” with radioactive material or radiation attenuating material. It says nothing about filling the balloon to match the size of the cavity, let alone filling it to “conform” the cavity.

In addition, Plaintiffs’ attempt to read a conformance limitation into claim element 1(e) does not square with Dr. Verhey’s own testimony on the subject. As far back as November 2006 in the *Xoft* case, Dr. Verhey stated that the “radial dose profile is defined as the absorbed dose to tissue as a function of distance from the center of the cavity along a particular direction of interest.” *See* Ex. H to Altemus Decl. (Verhey Decl. (Nov. 9, 2006) Appx. C at 6:21-28), *cited in* Pls’ Cl. Constr. Br. at 9. He reiterated the same position in his declaration in support of Plaintiffs’ Reply Claim Construction Brief in this case. *See* Verhey Decl. (May 30, 2008) at 3 (discussing a “more or less uniform” dose profile and explaining that “dose fall-off will be primarily a function of distance”). [REDACTED]

[REDACTED]

Equally unpersuasive is Plaintiffs' attempt to read a balloon-tissue conformance limitation into the "uniform" language of the preamble. Language in a claim preamble generally does not serve to limit claims. *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006); *Degeorge v. Bernier*, 768 F.2d 1318, 1322 n.3 (Fed. Cir. 1985). In particular, a preamble "is not limiting 'where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.'" *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)). "If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim." *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1435 (Fed. Cir. 2000); see also *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). As the preamble here adds no structure to the claim, it is "not limiting." *Catalina*, 289 F.3d at 808.

In any event, there is no basis to distinguish the meaning of "uniform" in the preamble from the means-plus-function limitation (e) in the body of the claim. The invention after the preamble is structurally complete, and the "uniform" language in the preamble simply states a "purpose or intended use" for the invention as defined in the claim body. The prosecution history supports this reading. During prosecution, the applicants changed the word "controlled" to "uniform" in the preamble of claim 1 at the same time they amended the means-plus-function claim limitation (e) to change "controlling the radial absorbed dose profile" to "rendering uniform the radial absorbed dose profile." Ex. 5 (Sep. 1, 1998 Am., '813 Prosecution History) at 1-2. Thus, it is clear the preamble merely refers to the claim limitation in (e), and does not state

1 a new claim limitation, [REDACTED]
 2 [REDACTED]
 3 [REDACTED]
 4 [REDACTED]

5 Finally, Plaintiffs' infringement position is further proof that Dr. Verhey's newly-
 6 proposed "conformance" requirement is driven by the need to avoid invalidity, and not by any
 7 actual limitation of claim 1 of the '813 patent. Plaintiffs first staked out a position on the
 8 requirements of claim element 1(e) in their preliminary infringement contentions. They made no
 9 mention that the Contura balloon "conformed" the tissue as Dr. Verhey now requires. *See* Ex. 11
 10 (Pls' Infr. Cont.) at Appx. A, 1-3, 7-9. Plaintiffs also failed to cite any claim limitation based on
 11 "uniform" in the preamble. *See* Ex. 11 (Pls' Infr. Cont.) at Appx. A, 1-3; Ex. 13 (Pls' Prel. Cl.
 12 Constr.) at Ex. A, 3. If, as Dr. Verhey asserts, the preamble and claim element 1(e) require
 13 "conformance," then Plaintiffs would have asserted the Contura meets that limitation in order to
 14 make their infringement case. Their failure to do so speaks for itself.

15 **B. "Adapted To Conform" and "Sufficiently Rigid To Deform" ('204 patent,**
 16 **Claim 4; '142 patent, Claim 8)**

17 Claim Term	SenoRx's Proposed Construction
18 the expandable outer 19 surface element is . . . adapted to contact / adapted to conform 20 ('204 patent, claim 4)	the expandable outer surface element is capable of contacting the tissue and capable of conforming the tissue. This does not require that the expandable outer surface actually contacts or conforms the tissue.
21 the expandable outer 22 surface is sufficiently rigid to deform the target tissue 23 ('142 patent, claim 8)	the expandable outer surface element is sufficiently rigid so as to be capable of deforming tissue. This does not require that the expandable outer surface actually deforms the target tissue.

24 Plaintiffs did not identify claim 4 of the '204 patent or claim 8 of the '142 patent as
 25 claims requiring construction in their preliminary claim construction disclosure, Joint Claim
 26 Construction Statement, or *Markman* briefs. Ex. 13 (Pls' Prel. Cl. Constr.) at Exs. B, C. [REDACTED]
 27 [REDACTED]
 28 [REDACTED]

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[REDACTED]

[REDACTED] Plaintiffs’ proposed constructions of these claim terms should be rejected as inconsistent with their plain and ordinary meaning, as well as with the intrinsic evidence.

The “adapted to” claim language in claim 4 resulted from a rejection by the PTO of the exact claim construction Plaintiffs now assert is correct. In the prosecution of the ’204 patent, the application was rejected for claiming that “the expandable surface element contacts . . . and conforms the tissue.” Ex. 20 (June 20, 2000 Office Action, ’204 Prosecution History) at 2. The examiner explained that this claim language impermissibly recited “a positive connection to the body.” *Id.* The examiner suggested the claim instead be amended to read “adapted to,” to eliminate this problem. *Id.* As a result, the applicants so amended claim 4, changing the claim language from “the expandable surface element contacts tissue . . . and conforms the tissue” to “the expandable surface element is adapted to contact tissue . . . and adapted to conform the tissue.” Ex. 8 (Dec. 20, 2000 Am., ’204 Prosecution History) at 2, 9 (emphases added). By amending the claim language, the applicants made clear the claim does not require the expandable surface element actually to contact and conform the tissue. Rather, the expandable surface element must be “adapted to” – capable of – contacting and conforming the tissue. This is entirely consistent with the plain meaning of the claim language. “Adapted to” means capable of. *See, e.g., In re Venezia*, 530 F.2d 956, 959 (CCPA 1976)⁴ (holding that a sleeve “adapted to be fitted over the insulated jacket of one of the cables” meant that each sleeve was so structured

⁴ Decisions of the CCPA are binding on the Federal Circuit. *South Corp. v. United States*, 690 F.2d 1368, 1370-71 (Fed. Cir. 1982) (en banc).

1 or dimensioned that it could be fitted over the insulated jacket of a cable); 1 *The Oxford English*
2 *Dictionary* 130 (Clarendon Press) (2d ed. 2001) (defining “adapted” as “suitable”) (attached
3 hereto as Ex. 21).

4 The same is true for the “sufficiently rigid” language of claim 8 of the ’142 patent. Claim
5 8 does not require that the expandable outer surface actually deform the target tissue. Rather, the
6 language of claim 8 requires that the “expandable outer surface is sufficiently rigid to deform the
7 target tissue.” Ex. 3 (’142 patent), claim 8. The claim language requires that the apparatus have
8 the property of being sufficiently rigid to deform. Put another way, the apparatus must be
9 sufficiently rigid so as to be capable of or suitable for deforming tissue. The plain claim
10 language does not require that the expandable outer surface actually deforms the tissue.

11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
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16 [REDACTED]
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19 [REDACTED]
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23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]

When the very same expert who put forth the construction disagrees with it, it is clear Plaintiffs' new limitations are entirely without support.

C. "Predetermined Asymmetric Isodose Curves" ('142 Patent Claims 1, 8).

Claim Term	SenoRx's Proposed Construction
the radiation source ... asymmetrically located and arranged within the expandable surface to provide predetermined asymmetric isodose curves with respect to the apparatus volume ('142 patent, claim 1) predetermined asymmetric isodose curves ('142 patent, claim 8)	SenoRx already has proposed a construction of "predetermined asymmetric isodose curves." "Predetermined" requires that the asymmetric isodose curves that will be created by the radiation source are determined prior to treatment. It does not require the ability to change the location and arrangement of radiation sources to provide any specific asymmetric isodose curves, but rather determining prior to treatment the isodose curves resulting from the actual asymmetric arrangement and location of the radiation source.

SenoRx asserted in its *Markman* briefs that "predetermined asymmetric isodose curves" in claims 1 and 8 and the '142 patent should be construed to mean "isodose curves determined before radiation is administered which are not substantially the same shape as the apparatus volume and/or not concentric with the apparatus volume." See Op. Br. at 23-24; Resp. Br. at 23-24. Dr. Verhey's expert report seeks to add new limitations to claims 1 and 8 of the '142 patent based on the term "predetermined" in an effort to argue against the invalidity of the claims over the prior art. The new limitations Dr. Verhey sets forth in his expert report are unsupported by the '142 patent and should be rejected.

Claims 1 and 8 of the '142 patent require that the radiation sources are asymmetrically arranged within the balloon so that they provide asymmetric isodose curves, and that the asymmetric isodose curves are "predetermined" – calculated – before treatment based on the relative position of the source(s) and the balloon.⁵ In their *Markman* briefs, Plaintiffs seemed to

⁵ As discussed in SenoRx's *Markman* briefs and Motion for Partial Summary Judgment, the claim also requires that the source(s) be spaced apart from the apparatus volume, which is

(continued...)

1 agree. Plaintiffs proposed no separate construction of “predetermined asymmetric isodose
 2 curves,” and described the requirement consistent with SenoRx’s proposed construction. *See*
 3 Pls’ Resp. Cl. Constr. Br. at 21-22 (“As a direct consequence of this asymmetric location and
 4 arrangement of the radiation source, ‘predetermined asymmetric isodose profiles’ are created.”).

5 [REDACTED]
 6 [REDACTED]
 7 [REDACTED]
 8 [REDACTED]
 9 [REDACTED]
 10 [REDACTED]
 11 [REDACTED]
 12 [REDACTED]

13 This construction is incorrect. The plain meaning of “predetermined” simply requires
 14 that the person administering radiation calculate prior to treatment the asymmetric isodose curves
 15 the device would generate. Indeed, “determine” means to ascertain what the curves will be.
 16 “Predetermined” is simply ascertaining what the curves will be before using the device. There is
 17 nothing in this concept that requires that the device have additional structure to give the user the
 18 flexibility to create any desired isodose curve. Rather, all the claim requires is that the radiation
 19 source is located asymmetrically so that it will provide asymmetric isodose curves which are
 20 determined before radiation is administered.

21 CONCLUSION

22 For the foregoing reasons, the Court should adopt SenoRx’s proposed constructions of
 23 the disputed terms of the ’813, ’204, and ’142 patents.

24
 25
 26 _____
 27 (...continued from previous page)
 28 impossible. *See* Op. Br. at 23; Resp. Br. at 21-23; Motion for Partial Summary Judgment of
 Invalidity.

1 Dated: June 20, 2008

Respectfully submitted,

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By: /s/ F.T. Alexandra Mahaney

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20
21 IN THE UNITED STATES DISTRICT COURT
22
23 NORTHERN DISTRICT OF CALIFORNIA
24
25 SAN JOSE DIVISION
26

27 HOLOGIC, INC., CYTYC CORP., and
28 HOLOGIC L.P.,

Plaintiffs,

v.

SENORX, INC.,

Defendant.

CASE NO.: 08-CV-0133 RMW

**DECLARATION OF ADAM D.
HARBER IN SUPPORT OF
DEFENDANT SENORX, INC.'S
SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEF**

Date: June 25, 2008

Time: 2:00 p.m.

Courtroom: 6, 4th Floor

Judge: Hon. Ronald M. Whyte

1 I, Adam D. Harber, declare that I am an associate at the law firm of Williams & Connolly
 2 LLP, admitted pro hac vice to practice before this Court in the above-captioned matter. I serve
 3 as outside counsel for Defendant SenoRx, Inc. The following declaration is based on my
 4 personal knowledge, and if called upon to testify, I could and would competently testify as to the
 5 matters set forth herein.

6 1. Attached hereto as Exhibit 18¹ is a true and correct copy of excerpts of the Expert
 7 Report of Lynn J. Verhey, Ph.D. (dated June 4, 2008).

8 2. Attached hereto as Exhibit 19 is a true and correct copy of excerpts of the
 9 transcript of the Deposition of Lynn J. Verhey (dated June 18, 2008).

10 3. Attached hereto as Exhibit 20 is a true and correct copy of excerpts of the June
 11 20, 2000 Office Action from the Patent Prosecution History for U.S. Patent No. 6,413,204.

12 4. Attached hereto as Exhibit 21 is a true and correct copy of excerpts of 1 *The*
 13 *Oxford English Dictionary* 130 (Clarendon Press) (2d ed. 2001).

14
 15 I declare under penalty of perjury that the foregoing is true and correct.

16
 17 Dated: June 20, 2008

18 By: 
 19 Adam D. Harber

20
 21
 22
 23
 24
 25
 26 ¹ The numbers assigned to exhibits attached to this Declaration run consecutively from the
 27 exhibit numbers of those attached to the Declaration of Adam D. Harber in Support of Defendant
 28 SenoRx, Inc.'s Opening Claim Construction Brief and the Declaration of Adam D. Harber in
 Support of Defendant SenoRx, Inc.'s Responsive Claim Construction Brief.

Exhibit 20



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/293,524	04/15/99	WINKLER	R 101360 <i>WE</i>

THOMAS J ENGELLENER
 NUTTER MCLENNEN & FISH
 ONE INTERNATIONAL PLACE
 BOSTON MA 02110-2699

QM32/0620

EXAMINER

LACYK, J

ART UNIT	PAPER NUMBER
----------	--------------

3736 *J*

DATE MAILED:

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. <u>09/293,524</u>	Applicant(s) <u>WINKLER et al</u>
	Examiner <u>LacyK</u>	Group/Art Unit <u>3736</u>

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-34 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3-4

☒ Notice of Reference(s) Cited, PTO-892

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-162

☐ Other _____

Office Action Summary

Application/Control Number: 09/293,524

Page 2

Art Unit: 3736

1. Claims 2,4,5,14,22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 3, the use of "may include" is indefinite in that it is unclear whether the limitations that follow are included or not. Similarly in claim 26. In claims 4 and 28, the use of "adapted to" language should be used to avoid claiming a positive connection to the body. Claims 5 and 29 are indefinite in that there is no claimed structure to support the functional language recited in the claim. There are no structural limitations claimed to support how the apparatus "creates absorbed isodose profiles". In claim 14, "the burst strength" lacks positive antecedent basis. Claims 22-29 should be recited in an active state, i.e. placing the radioactive source, removing the radioactive source, resecting the proliferating tissue, etc.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-14, 18-34 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 5,913,813 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a radioactive therapy device having a catheter with an inner spatial volume disposed on the distal end of the catheter with an outer spatial volume having an expandable surface element disposed on the distal end of the catheter in a surrounding relation to the inner spatial volume and having a radiation source disposed in the inner spatial volume.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ishiwara et al.

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Ishiwara et al discloses the claimed device, as shown in the embodiment of Figure 5.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bradshaw et al or Weinberger.

See the embodiment of Figure 17 of Weinberger.

7. Claims 1 and 21-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Williams '582.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams '582.

Although Williams does not specifically disclose using the device to treat the breast, a modification of Williams to do so would have been obvious to one of ordinary skill in the art at the time the invention was made in that one skilled in the art would readily know that the device could be used in any part of the body to treat tissue surrounding a cavity left by surgical removal of a tumor.

10. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger or Bradshaw et al in view of Clerc et al.

Bradshaw et al and Weinberger disclose the claimed device except for the use of an expandable cage instead of a balloon. Clerc et al discloses a self-expanding "cage" (12) that is

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used to help deliver radioactive therapy. Clerc et al discloses the support having a shape memory such that it is self opening. Further to use any known shape memory material such as nitinol would have been obvious since nitinol is well known and conventionally used with radioactive therapy devices. Therefore a modification of Bradshaw et al or Weinberger such that a "cage" or support is used instead of a balloon would have been obvious.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is (703) 308-2995.


JOHN P. LACYK
PRIMARY EXAMINER

J.P. Lacyk

June 16, 2000

TO SEPARATE, HOLD TOP AND BOTTOM EDGES, SNAP-APART, AND DISCARD CARBON

FORM PTO-892 (REV. 2-82)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		SERIAL NO. 09/293524	GROUP/ART UNIT 3736	ATTACHMENT TO PAPER NUMBER 5	
NOTICE OF REFERENCES CITED				APPLICANT(S) WINKLER et al			
U.S. PATENT DOCUMENTS							
	DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE	
A	5924973	7/2/99	WINKLER	600	3	9/26/96	
B	5913813	6/22/99	WILLIAMS et al	600	3		
C	6059812	5/9/2000	CLERK et al	600	3	3/6/98	
D							
E							
F							
G							
H							
I							
J							
K							
FOREIGN PATENT DOCUMENTS							
	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SHTS. PP. DWG. SPEC.
L							
M							
N							
O							
P							
Q							
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)							
R							
S							
T							
U							
EXAMINER		DATE					
* A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05 (a).)							

Form PTO 948 (Rev. 8-98)

U.S. DEPARTMENT OF COMMERCE - Patent and Trademark Office

Application No.

929 3524

NOTICE OF DRAFTSPERSON'S
PATENT DRAWING REVIEWThe drawing(s) filed (insert date) 415 99A. ☐ approved by the Draftsperson under 37 CFR 1.84 or 1.152.B. ☒ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawing must be submitted according to the instructions on the back of this notice.

<p>1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:</p> <p>Black ink. Color.</p> <p>Color drawings are not acceptable until patent is granted.</p> <p>Fig(s) _____</p> <p>Pencil and non black ink not permitted. Fig(s) _____</p> <p>2. PHOTOGRAPHS. 37 CFR 1.84 (b)</p> <p>1 full-tone set is required. Fig(s) _____</p> <p>Photographs not properly mounted (must use bristol board or photographic double-weight paper). Fig(s) _____</p> <p>Poor quality (half-tone). Fig(s) _____</p> <p>3. TYPE OF PAPER. 37 CFR 1.84(c)</p> <p>Paper not flexible, strong, white, and durable.</p> <p>Fig(s) _____</p> <p>Erasures, alterations, overwritings, interlineations, folds, copy machine marks not accepted. Fig(s) _____</p> <p>Mylar, velum paper is not acceptable (too thin). Fig(s) _____</p> <p>4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:</p> <p>21.0 cm by 29.7 cm (DIN size A4)</p> <p>21.6 cm by 27.9 cm (8 1/2 x 11 inches)</p> <p>All drawing sheets not the same size.</p> <p>Sheet(s) _____</p> <p>Drawings sheets not an acceptable size. Fig(s) _____</p> <p>5. MARGINS. 37 CFR 1.84(g): Acceptable margins:</p> <p>Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm</p> <p>SIZE: A4 Size</p> <p>Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm</p> <p>SIZE: 8 1/2 x 11</p> <p>Margins not acceptable. Fig(s) _____</p> <p>Top (T) _____ Left (L) _____</p> <p>Right (R) _____ Bottom (B) _____</p> <p>6. VIEWS. 37 CFR 1.84(h)</p> <p>REMINDER: Specification may require revision to correspond to drawing changes.</p> <p>Partial views. 37 CFR 1.84(h)(2)</p> <p>Brackets needed to show figure as one entity.</p> <p>Fig(s) _____</p> <p>Views not labeled separately or properly.</p> <p>Fig(s) _____</p> <p>Enlarged view not labeled separately or properly.</p> <p>Fig(s) _____</p> <p>7. SECTIONAL VIEWS. 37 CFR 1.84 (h)(3)</p> <p>Hatching not indicated for sectional portions of an object.</p> <p>Fig(s) _____</p> <p>Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____</p>	<p>8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)</p> <p>Views do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____</p> <p>9. SCALE. 37 CFR 1.84(k)</p> <p>Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction.</p> <p>Fig(s) _____</p> <p>10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)</p> <p>Lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). Fig(s) _____</p> <p>11. SHADING. 37 CFR 1.84(m)</p> <p>Solid black areas pale. Fig(s) _____</p> <p>Solid black shading not permitted. Fig(s) _____</p> <p>Shade lines, pale, rough and blurred. Fig(s) _____</p> <p>12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)</p> <p>Numbers and reference characters not plain and legible. Fig(s) _____</p> <p>Figure legends are poor. Fig(s) _____</p> <p>Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(1)</p> <p>Fig(s) _____</p> <p>English alphabet not used. 37 CFR 1.84(p)(2)</p> <p>Figs _____</p> <p>Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3)</p> <p>Fig(s) _____</p> <p>13. LEAD LINES. 37 CFR 1.84(q)</p> <p>Lead lines cross each other. Fig(s) _____</p> <p>Lead lines missing. Fig(s) _____</p> <p>14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)</p> <p>Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Sheet(s) _____</p> <p>15. NUMBERING OF VIEWS. 37 CFR 1.84(u)</p> <p>Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____</p> <p>16. CORRECTIONS. 37 CFR 1.84(w)</p> <p>Corrections not made from prior PTO-948 dated _____</p> <p>17. DESIGN DRAWINGS. 37 CFR 1.152</p> <p>Surface shading shown not appropriate. Fig(s) _____</p> <p>Solid black shading not used for color contrast. Fig(s) _____</p>
<p>COMMENTS</p>	

REVIEWER DeNiro

DATE

5/7/99

TELEPHONE NO. _____

ATTACHMENT TO PAPER NO. 5

Exhibit 21

THE OXFORD ENGLISH DICTIONARY

SECOND EDITION

Prepared by

J. A. SIMPSON *and* E. S. C. WEINER

VOLUME I

A–Bazouki

CLARENDON PRESS · OXFORD

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II. Weiner, Edmund S. C., 1950–
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prepared by J. A. Simpson and E. S. C. Weiner

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APERTE

importance than appearance. 1937 E. J. LABARRE
per 3/1 *Adansonia*, inner bark of *Adansonia digitata*
used to a limited extent for wrapping papers.

apertile, *a.* *Obs.* -0 [ad. L. *apertilis* that
opened, *f. ad* intensive + *aperire* to
-ILE.] 'Easy to be opened.' Bailey, vol.
11.

ad (ædæpɪd), *sb.* and *a.* *Palæont.* [f. mod. L.
rabbit, of unkn. origin (adopted as a
name by G. Cuvier 1822, in *Ossements*
(ed. 2) III. 265) + -ID³.] *A. sb.* A
member of the extinct family Adapidæ of
primate-like primates, known from Eocene fossils
Europe, North America, and Asia. *B. adj.* Of,
pertaining to, or designating this animal.

ad (ædæpɪd), *sb.* and *a.* *Palæont.* [f. mod. L.
rabbit, of unkn. origin (adopted as a
name by G. Cuvier 1822, in *Ossements*
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member of the extinct family Adapidæ of
primate-like primates, known from Eocene fossils
Europe, North America, and Asia. *B. adj.* Of,
pertaining to, or designating this animal.

adapt (ə'dæpt), *v.* [a. Fr. *adapter*, ad. L.
adaptā-re, *f. ad* to + *aptā-re* to fit; *f. apt-us* fit;
see *APT*.]

1. To fit (a person or thing to another, to or for
a purpose), to suit, or make suitable.

1611 FLORIO, *Additare*, to fit, to adapt, to appropriate
[not in ed. 1598]. 1616 B. JONSON *Discov.* Wks. 1616 II.
128 He is adapted to it by nature. 1636 HEALEY *Epictetus*
Man. xlii. 65 Adapt the discourses of thy friends unto thine
owne as neere as thou canst. 1763 MILLER *Gard. Dict.*, A
seminary is a seed-plot, which is adapted or set apart for the
sowing of seeds. 1756 BURKE *Subl.* & B. Wks. I. 182 The
senses strongly affected in some one manner, cannot quickly
change their tenour, or adapt themselves to other things.
1847 YEOWELL *Anc. Brit.* Ch. i. 5 To have adapted poetry to
the preservation of their historical memorials. 1855 BAIN
Senses & Intell. II. ii. 33 (1864) 209 'The structure of the
outer ear is adapted to collect and concentrate the
vibrations.

2. *a.* To alter or modify so as to fit for a new
use.

1774 BRYANT *Mythol.* I. 117 It is called *Anchia*. it
signified either *fons spelunca*, or *spelunca fontis*, according as
it was adapted. 1858 HAWTHORNE *Fr. & It.* *Jrnl.* II. 199. A
kind of farm-house, adapted, I suppose, out of the old ruin.

b. To construct or produce by adaptation
from.

1805 J. WILD (title) *Dramas Adapted* (from the Original
French) to the English Stage. 1849 *Athenaeum* 3 Nov. 1113/3
A three-act drama adapted from the French comedy. 1852
C. READS (title) *The Lost Husband*. A drama... written and
adapted from the French. 1911 (title) *The Concise Oxford*
Dictionary of Current English adapted by H. W. Fowler and
F. G. Fowler... from *The Oxford Dictionary*.

3. *intr.* To undergo modification so as to fit for
a new use, etc. *Const.* to. Also *absol.*

1956 M. BRYAN *Intent to Kill* vi. 67 In our country, the
rich have no sense of responsibility. I wonder how they will
adapt to the future. 1962 *Listener* 3 May 762/1 Birds
certainly adapt to the urban community, and particularly
well to the suburban community. *Ibid.* 19 July 84/1 There
is an absolute lack of imagination, or failure to adapt, a
refusal to face the need for change.

†**adapt**, *ppl. a.* *Obs.* [f. ADAPT *v.* on analogy of
ppl. adjs. like *content*, *distract*, *erect*, which were
in form identical with verbs, though really
adaptations of L. *pples.* in -tus; but there was no
L. *adaptus*. The *adj. APT* may also have helped
in the production of *ad-apt*.] Fitted, suited; fit.

1704 SWIFT *T. of a Tub* ix. Wks. 1760 I. 100 This
definition of happiness... will be acknowledged wonderfully
adapt. 1733 NORTH *Lives of Norths* II. 369 Nothing could
have fallen out more exquisitely adapt to Mr. North's
desires.

adaptability (ædæptə'bɪlɪtɪ). [f. ADAPT *a.*;
see -BILITY.] The quality of being adaptable;
capacity of being adapted or of adapting oneself;
potential fitness. *Const.* to, for.

1661 R. LOVELL *Anim. & Min.* 315 The manner of using,
adaptability of the matter, and nature of the patient. 1796
W. TAYLOR in *Monthly Rev.* XIX. 513 Adaptability to
define and discriminate contiguous shades of idea. 1845
TODD & BOWMAN *Phys. Anat.* I. 149 One of the most
wonderful circumstances in the construction of the hand, is
its adaptability to an infinite number of offices. 1873 FARRAR
Famil. of Sp. ii. 69 General adaptability for every purpose.
1875 STUBBS *Const. Hist.* II. xv. 293 The adaptability of his
people to the execution of his design.

adaptable (ə'dæptəb(ə)l), *a.* [f. ADAPT *v.* +
-ABLE, as if ad. L. **adaptabilis*.] Capable of
being adapted; applicable; pliable.

1800 W. TAYLOR in *Monthly Mag.* X. 317 The very metre
employed... is no less adaptable to the other Gothic dialects
than to the German. 1857 TOULM. SMITH *Parish* I.
Principles, which are adaptable to all the changing
conditions of human progress. 1865 TRAFFORD *Geo. Geith*
II. vi. 58 Before marriage men are not so adaptable as
women.

adaptableness (ə'dæptəb(ə)lnɪs). [f. prec. +
-NESS.] = ADAPTABILITY.

†**adaptate**, *v.* *Obs. rare.* [f. L. *adaptāt-* *ppl.*
stem of *adaptā-re*; see ADAPT, and -ATE.] A
byform of ADAPT.

1659 *Instr. Oratory* 26 Those [words] derived from the
Latin... being... more adapted for many discourses. 1678
CUDWORTH *Intell. Syst.* I. v. 690 It is your work now to
Adaptate the Mortal to the Immortal.

adaptation (ædæp'teɪʃən). [a. Fr. *adaptation*,
ad. late L. *adaptatiō-em*, n. of action *f.*
adaptā-re; see ADAPT. Not in Cotgr. 1632; see
ADAPTING *vbl. sb.*]

1. The action or process of adapting, fitting, or
suiting one thing to another.

1610 HEALEY *St. Aug., City of God* 743 They... made a
very ingenious adaptation of the one to the other. 1646 SIR
T. BROWNE *Pseud. Ep.* III. xi. 130 A commixtion of both in
the whole rather than an adaptation or cement of the one
unto the other. 1782 PRIESTLEY *Nat. & Recl. Relig.* I. 29
There are... many adaptations of one thing to another. 1881
LUBBOCK in *Nature* No. 618, 411 Electricity in the year 1831
may be considered to have just been ripe for its adaptation
to practical purposes.

2. *a.* The process of modifying a thing so as to
suit new conditions: as, the modification of a
piece of music to suit a different instrument or
different purpose; the alteration of a dramatic
composition to suit a different audience; the
alteration of form which a word of one language
often undergoes to make it fit the etymological
or phonetic system of another, as when the L.
adaptatiōnem is taken into Fr. and E. as
adaptation.

1790 PALEY *Hor. Paul.* I. 3 His adaptation will be the
result of counsel, scheme, and industry. 1846 KINGSLEY
Lett. (1878) I. 140 Man has unrivalled powers of self-
adaptation. 1878 C. PARRY in *Grove Dict. Music* I. 89
Arrangement, or adaptation, is the musical counterpart of
literary translation.

b. spec. in Opt. The adjustment of the eye to
variations in the intensity or colour of light.
Also = ACCOMMODATION *1 b.*

1881 in *Syd. Soc. Lex.* 1920 *Jrnl. Gen. Phys.* II. 499 The
phenomenon of retinal adaptation is one of the most familiar
facts of sensory physiology. *Ibid.* 516 During the dark
adaptation of the human eye, its visual threshold decreases
to a small fraction of its original value in the light. 1950 L.
C. THOMSON in *Brit. J. Ophthalmology* Mar. 145 The
sensory receptor cells in the retina... play a part in visual
adaptation. 1960 R. A. WEALE *Eye & its Function* vii. 110
Chromatic adaptation experiments, in which the eye is
exposed continuously to a coloured background of moderate
luminance.

3. The condition or state of being adapted;
adaptedness, suitability.

1677 HALE *Prim. Orig. Man.* I. i. 2 This adaptation and
congruity of these faculties to their several proper Objects.
1751 JOHNSON *Rambling* No. 160 ¶ 2 The benefit of this
adaptation of men to things is not always perceived. 1836 J.
GILBERT *Atoneum* viii. (1852) 230 He perceives its
adaptation to melt his mind. 1867 J. MARTINEAU *Chr. Life*
(ed. 4) 291 The adaptation of immortality to our true wants.

4. A special instance of adapting; and hence,
concr. an adapted form or copy, a reproduction
of anything modified to suit new uses.

1859 DARWIN *Orig. Spec.* iii. (1873) 48 We see beautiful
adaptations everywhere and in every part of the organic
world. 1860 *Sat. Rev.* No. 250, 181/2 A French play is
adapted by A. B. either appropriates A's adaptation or
makes another. *Mod.* The word *piroch* is our adaptation of
the Gaelic *piobaireachd*, that is to say 'piper-ship.'

5. *Biol.* Organic modification by which an
organism or species becomes adapted to its
environment.

1859 DARWIN in *Jrnl. Linn. Soc. Zool.* III. 50 The most
vigorous and healthy males, implying perfect adaptation,
must generally gain the victory in their contests [for the
females]. 1875 *Encycl. Brit.* I. 145/2 Adaptation... is usually
restricted... to imply such modifications as arise during the
life of an individual, when an external change directly
generates some change of function and structure. 1897 H. F.
OSBORN in *Science* 15 Oct., Ontogenetic adaptation...
enables animals and plants to survive very critical changes in
their environment. 1904 H. E. CRAMPTON in *Biometrika* III.
114 A rigid... organization, incapable... of structural
alterations as the result of 'functional adaptation'. 1923 J. S.
HUXLEY *Ess. of Biologist* i. 13 If the degree of adaptation has
not increased during evolution, then it is clear that progress
does not consist in increase in adaptation.

adaptational (ædæp'teɪʃənəl), *a.* [f. prec. +
-AL¹.] Of or pertaining to adaptation.

1879 LUBBOCK *Scient. Lect.* ii. 42 The modifications
which insect larvæ undergo may be divided into two kinds
—developmental, and adaptational or adaptive; those
which tend to suit them to their own mode of life.

adaptive (ə'dæptɪv), *a.* [f. L. *adaptāt-* *ppl.*
stem of *adaptā-re* to ADAPT + -IVE.]
Characterized by, or given to, adapting things to
a purpose, or oneself to circumstances; =
ADAPTIVE.

1857 TOMES *Amer. in Japan* xi. 247 The Japanese are... a
very imitative, adaptive, and compliant people. 1870
PROCTOR *Other Worlds* iii. 81 Adaptive power... by which
the various creatures we are acquainted with are enabled to
live in comfort under all degrees of light. 1875 STUBBS
Const. Hist. II. xv. 207 The great merit of his statesmanship

ADAPTIVE

adaptativeness (ə'dæptətɪvnɪs). [f. prec. +
-NESS.] Ability to suit things to a purpose, or
oneself to circumstances; = ADAPTIVENESS.

1881 *Harper's Mag.* Apr. 645 He possessed plenty of that
Yankee adaptativeness.

adapted (ə'dæptɪd), *ppl. a.* [f. ADAPT *v.* + -ED.]
1. Fitted; fit, suitable. *Const.* to, for.

1610 HEALEY *St. Aug., City of God* 844 As spirits doe in
characters and signes ad-adapted to their natures. 1754
CHATHAM *Lett. to Nephew* v. 37 A proper behaviour,
adapted to the respective relations we stand in. 1803 W.
TAYLOR in *Ann. Rev.* I. 35 Confering on Mr. Collins an
adapted and distinguished appointment. 1875 DARWIN
Insectiv. Plants i. 3 *Drosera* was excellently adapted for...
catching insects.

2. Modified so as to suit new conditions.

1816 SOUTHEY *Poet's Pilgr.* iv. 52 Wks. X. 103 A race, who
with the European mind, The adapted mould of Africa
combined. *Mod.* Adapted comedies are being played at
several theatres. *Syntax* is the adapted form in which the
Greek *σύνταξις* is used in English.

adaptedness (ə'dæptɪdnɪs). [f. prec. + -NESS.]
The quality or state of being adapted or suited;
suitableness, special fitness.

1698 [R. FERGUSSON] *View of Eccles.* 18 Their adaptedness
for their employ. 1800 W. TAYLOR in Robberds' *Memoir* I.
327 The adaptedness of one rhythm or form of stanza for
one purpose, and of another for a different purpose, is
wholly, or nearly so, the result of association. 1875
WHITNEY *Life of Lang.* xiv. 293 When the time for the use
came, the perception of its adaptedness... necessarily
followed.

adapter, -or (ə'dæptə(r)). [f. ADAPT *v.* + -ER¹.]

1. One who adapts. *a.* One who fits or suits one
thing to another. *b.* One who modifies or alters
a composition to suit it to new purposes.

1801 CHALMERS *Lett. in Life* (1851) I. 48 Such adaptation
speaks of a divine and intelligent adapter. 1858 DE QUINCY
Wks. VI. 374 If these imaginary adapters of Homer,
according to the German pretence, modernised his whole
diction. 1865 *Sat. Rev.* 12 Aug. 210/1 The original author is
of opinion that the adapter has not mended but marred his
work. 1877 R. H. HUTTON *Ess.* (ed. 2) I. 43 Intelligence is
the conscious and voluntary adapter of means to ends.

2. A connecting part: in *Chem.* a tube to
connect two pieces of apparatus; in *Optics*, a
metal ring with screw threads to unite two
lengths of a telescope; a 'sliding fitting' in an
optical instrument.

1808 SIR H. DAVY in *Phil. Trans.* Vol. XCIX. 454 The
adapters must have contained 8 of a similar gas. 1867 J.
HOGG *Microsc.* I. iii. 170 A flat piece of glass placed at an
angle of 45° across the tube, interposed like an adapter
between the objective and the microscope-body. 1875 URE
Dict. Arts I. 7 An adapter tube is then fitted to the lateral
cylinder. This adapter enters into another tube at the same
degree of inclination. 1876 CHAMBERS *Astron.* 623 A more
simple form of solar eye-piece is that which consists of an
adapter in which a diaphragm plate is fitted as above.

3. *Electr. Engin.* (See *quots.*)

1907 T. O'C. SLOANE *Stand. Electr. Dict.* (ed. 12) 11
Adapter, a screw coupling to engage with a different sized
screw on each end; one of the uses is to connect incandescent
lamps to gas-fixtures. 1913 E. E. BECKER & Co. *Illustr.*
Catal. Sci. App. 539 (caption) Plug adaptor, for tapping
current off any ordinary bayonet-catch lamp-holder. 1943
Gloss. Terms Electr. Engin. (B.S.I.) 123 *Socket-outlet*
adaptor, an accessory for insertion into a socket-outlet and
containing metal contacts to which may be fitted one or
more plugs for the purpose of connecting to the supply
portable lighting fittings or other current-using appliances.

adapting (ə'dæptɪŋ), *vbl. sb.* [f. ADAPT *v.* +
-ING¹.] The action of fitting, suiting, or
rendering suitable. (Now mostly gerundial.)

1632 COTGR., *Adaptation* [Fr.] An adapting, fitting, or
suiting of one thing to another. 1656 COWLEY *Davidides* I.
(1684) 35 An adapting of all these to the Constitution,
Disposition, and Inclinations of the Patient. 1714 SWIFT
State of Aff. Wks. 1755 II. i. 205, I do not know a greater
mark of an able minister, than that of rightly adapting the
several faculties of men. *Mod.* This clever adapting of
means to ends. He is skilled in adapting French plays.

adapting (ə'dæptɪŋ), *ppl. a.* [f. ADAPT *v.* +
-ING¹.] Rendering suitable, modifying.

1836 J. GILBERT *Atoneum* iv. (1852) 91 The adapting
intelligence which limited their energy to the discharge of
that office.

adaption (ə'dæptɪən). [f. ADAPT *v.* as if formed
on a L. *ppl. stem*; cf. *adapt-ion*. See -ION¹.] =
ADAPTATION; the action of adapting.

1704 SWIFT *T. of a Tub* (1768) I. 127 For great turns are
not always given by strong hands, but by lucky adaption.
1790 BLAGDEN *Spirit. Liq. in Phil. Trans.* LXXX. 344 The
adaption of the duties to different degrees of strength. 1860
DICKENS *Lett.* (ed. 2) II. 124 There it is, needing no change
or adaption.

adaptitude (ə'dæptɪtjuːd). [A mixture of ADAPT
and APTITUDE.] Adaptedness; aptitude specially
produced.

1842 MRS. BROWNING *Grk. Chr. Poets* 129 A hedge-thorn
catches sheep's wool by position and approximation rather
than adaptitude. 1852 BROWNING *Ess. on Shelley* (1881) 16
A profound sensibility and adaptitude for act.

adaptive (ə'dæptɪv), *a.* [irreg. *f.* ADAPT *v.* +
-IVE, as if on *ppl. stem*; cf. *adapt-ive*; see -IVE.]
Characterized by, or given to, adaptation

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SENORX, INC.

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORP., and
HOLOGIC L.P.,

Plaintiffs,

v.

SENORX, INC.,

Defendant.

CASE NO.: C08 0133 RMW

**STIPULATION IN SUPPORT OF
MOTION FOR ADMINISTRATIVE
RELIEF FOR PERMISSION TO
FILE SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEFS
PURSUANT TO CIVIL LOCAL
RULES 7-11 AND 7-12**

1 Plaintiffs Hologic, Inc., Cytac Corporation, and Hologic L.P. and Defendant SenoRx, Inc.
 2 hereby submit this stipulation in support of the parties' Motion for Administrative Relief for
 3 Permission to File Supplemental Claim Construction Briefs.

4 The claim construction hearing in this case is scheduled to be held on June 25, 2008. The
 5 parties submitted opening claim construction briefs on May 21, 2008 and responsive claim
 6 construction briefs May 30, 2008. Subsequent to submitting these briefs, the parties determined
 7 there was a dispute as to the meaning of additional claim terms in the patents-in-suit that were not
 8 raised in the parties' original claim construction briefs. Accordingly, the parties request that the
 9 Court consider and issue a ruling on the parties' supplemental claim constructions of the disputed
 10 terms. Plaintiffs' supplemental claim construction brief, with exhibits, is attached as Exhibit A to
 11 the Motion for Administrative Relief. Defendant's supplemental claim construction brief, with
 12 exhibits, is attached as Exhibit B to the Motion for Administrative Relief.

13
 14 Dated: June 20, 2008

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Filer's Attestation

I, F.T. Alexandra Mahaney, am the ECF User whose identification and password are being used to file this Stipulation in Support of Motion for Administrative Relief for Permission to File Supplemental Claim Construction Briefs. Pursuant to General Order No. 45, ¶ X(B), I attest under penalty of perjury that concurrence in the filing of the document has been obtained from the other signatures above.

By: /s/F.T. Alexandra Mahaney
F.T. Alexandra Mahaney

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v.

SENORX, INC.,

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CASE NO.: C08 0133 RMW

**[PROPOSED] ORDER GRANTING
MOTION FOR ADMINISTRATIVE
RELIEF FOR PERMISSION TO
FILE SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEFS
PURSUANT TO CIVIL LOCAL
RULES 7-11 AND 7-12**

[PROPOSED] ORDER GRANTING MOTION
FOR ADMINISTRATIVE RELIEF FOR
PERMISSION TO FILE SUPPLEMENTAL
CLAIM CONSTRUCTION BRIEFS

CASE NO. C08-0133 RMW

1 PURSUANT TO STIPULATION, IT IS SO ORDERED. The Court hereby grants the
2 parties' Motion for Administrative Relief for Permission to File Supplemental Claim
3 Construction Briefs. The supplemental claim construction briefs attached as Exhibit A and
4 Exhibit B to the parties' Motion are hereby deemed filed.

5
6 DATED: June __, 2008

7 _____
The Honorable Ronald M. Whyte
United States District Court Judge
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